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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,356	12/21/2001	Daniela Giacchetti	05725.0986-00	4644

22852 7590 04/05/2006

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EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/024,356

Applicant(s)

GIACCHETTI ET AL.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-59 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION
Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-22, drawn to a method of helping a consumer make a cosmetic product purchasing decision, classified in class 705, subclass 16.
- II. Claims 23-27, drawn to a method of classifying cosmetic products, classified in class 707, subclass 100.
- III. Claims 28-36, drawn to a method of prescribing cosmetic products, classified in class 705, subclass 2.
- IV. Claims 37-39, drawn to a system for helping a consumer select a cosmetic product, classified in class 600, subclass 407.
- V. Claims 40-55, drawn to a computer-readable medium containing instructions for causing a computer to perform a method of helping a consumer make a cosmetic product purchasing decision, classified in class 707, subclass 104.1.
- VI. Claim 56, drawn to a method of helping a consumer make a cosmetic product purchasing decision, classified in class 705, subclass 1.
- VII. Claim 57, drawn to an apparatus for helping a consumer make a cosmetic product purchasing decision, classified in class 434, subclass 262.
- VIII. Claim 58, drawn to an apparatus for helping a consumer make a cosmetic product purchasing decision, classified in class 434, subclass 377.
- IX. Claim 59, drawn to an apparatus for helping a consumer make a cosmetic product purchasing decision, classified in class 434, subclass 99.

Group A includes inventions I – III and VI directed to methods.

Group B includes inventions IV, V and VII – IX directed to systems.

Groups A and B are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially

different process. (MPEP 806.05(e)).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group B requires the use of computers, while Group A can be performed manually.

Because these inventions are distinct for these reasons and the search required for Group A is not required for Group B, restriction for examination purposes as indicated is proper.

Group A (Inventions I – III and VI)

Within Group A **inventions I and II** are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP 806.05(c)).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention I requires:

"associating with the at least one presented product, an indicator of predicted compatibility between the at least one presented product and the consumer".

The subcombination has separate utility such as:

"causing at least some of the plurality of cosmetic products to be classified by a predicted degree of compatibility with the consumer."

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Within Group A **inventions I and III** are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP 806.05(c)).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention I requires:

"maintaining information reflective of compatibility between cosmetic products and personal characteristics of a plurality of subjects";

and

"associating with the at least one presented product, an indicator of predicted compatibility between the at least one presented product and the consumer".

The subcombination has separate utility such as:

"maintaining in a data structure information based on the use of a plurality of cosmetic products by a plurality of subjects having varying personal characteristics; maintaining in the data structure information reflective of at least some of the personal characteristics of the subjects";

and

"causing a display to the consumer of representations of at least some of the plurality of cosmetic products prioritized by degree of predicted compatibility with the consumer."

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Within Group A **inventions II and III** are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP 806.05(c)).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention I requires:

"associating with the at least one presented product, an indicator of predicted compatibility between the at least one presented product and the consumer".

The subcombination has separate utility such as:

"causing a display to the consumer of representations of at least some of the plurality of cosmetic products".

Because these inventions are distinct for the reasons given above and have

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acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Group B (Inventions IV, V and VII – IX)

Within Group B **inventions IV and V** are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP 806.05(c)).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention I requires:

"a classifier indicating a degree of compatibility between the at least one product and the consumer".

The subcombination has separate utility such as:

"a display for "presenting to the consumer an indication of at least one of the plurality of cosmetic products".

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Within Group B **inventions IV and VII** are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP 806.05(c)).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention I requires:

"a classifier indicating a degree of compatibility between the at least one product and the consumer".

The subcombination has separate utility such as:

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"a processor configured to "associate with the at least one presented product, an indicator of predicted compatibility between the at least one presented product and the consumer".

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Within Group B **inventions IV and VIII** are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP 806.05(c)).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention I requires:

"a classifier indicating a degree of compatibility between the at least one product and the consumer".

The subcombination has separate utility such as:

"an indicator of predicted compatibility between the at least one presented product and the consumer".

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Within Group B **inventions IV and IX** are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP 806.05(c)).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention I requires:

"a data structure containing information about personal characteristics of a plurality of test subjects, the data structure further containing information reflective of a degree of compatibility

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between at least some of the cosmetic products and the physical characteristics of at least some of the subjects".

The subcombination has separate utility such as:

a computer configured to "receive, from a cosmetic service, a request for personal information from the consumer".

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

A reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141 . If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP j 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB
3/16/2006

IGOR N. BORISSOV
PRIMARY EXAMINER

